

Appl. No. 09/890,357

REMARKS

Claims 1-43 are pending in this application. The Examiner will note that the claims have been amended to correct misspellings. The Examiner will also note that new claims 44-59 are directed to a process for preparing the catalyst system. Support for new claims may be found in the claims as originally filed. Applicant submits that these newly added claims are also patentable for the reasons set forth below. No new matter has been added.

1. Claim Objections

The Examiner has indicated that claims 28 and 29 have been objected because it is unclear what the weight ratio refers to. Applicant has amended these claims to clarify that the weight ratio relates to ratio between the solid transition metal compound and the oil. Reconsideration and removal of the objection is respectfully requested.

2. Claim Rejections under 35 U.S.C. §112

The Examiner has rejected claims 21-27 and 41-43 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. The claims in question are directed to a process for polymerizing α -olefins using the novel catalyst system described in the application. The Examiner argues that these claims are indefinite because they omit essential steps. The Examiner appears to suggest that the claims must be amended to (1) include the specific type of catalyst used; (2) specify whether the catalyst is pre-activated when it is introduced or whether co-catalysts or activators are required; (3) specify the conditions (temperature, pressure, rate of introductions, phase, etc.) under which the α -olefin is contacted with the catalyst system; (4) define the type of α -olefins used in the systems and (5) specify the order of contact for the materials. Applicant disagrees.

As noted by the Examiner, the application contains allowable subject matter, specifically the subject matter of claim 3 which is directed to the novel catalyst system. Applicant has amended claim 1 to incorporate the limitations of claim 3 and has similarly amended claim 21. Applicant has also added new claims 44-59 which are directed to a process of preparing the catalyst system. Since

Appl. No. 09/890,357

the catalyst system has been found to be novel and non-obvious, Applicant submits that the use of the catalyst system to polymerize α -olefins, as well as the process for its preparation, would also be novel and non-obvious. Although Applicant has amended claim 21 to further define the catalyst system used in the process, Applicant does not agree that all of the other limitations noted above need to be included within the claim because they are not necessary or essential elements. In particular, Applicant submits that the conditions for polymerization, the types of α -olefins to be used, etc. need not be included within the claims because they are not required for purposes of patentability. These parameters are described at length in the application and would be well understood by the skilled artisan. As such, Applicant submits that the process claimed in amended claim 12 is clear and definite and satisfies the requirements of 35 U.S.C. §112, second paragraph. Reconsideration and removal of the rejection is respectfully requested.

3. Claim Rejections under 35 U.S.C. §102/103(a)

The Examiner has issued four separate rejections under 35 U.S.C. §102/103(a). Claims 1-2, 4-6, 9-10, 14-17, 20, 30-32, 34 and 36-38 have been rejected as anticipated by or, in the alternative, as obvious over CN 1183788. Claims 1-2, 4, 15-17, 20-23, 27, 30, 36-37 and 42-43 have been rejected as anticipated by or, in the alternative, as obvious over Hermann et al. Claims 1-2, 4, 7-8, 15-17, 20, 21-23, 27, 30, 36-37 and 43 have been rejected as anticipated by or, in the alternative, as obvious over Kawasaki et al. Finally, claims 1-2, 4, 14-17, 20-23, 27, 36-37 and 42-43 have been rejected as anticipated by or, in the alternative, as obvious over Rifi et al.

As noted above, Applicant has amended independent claim 1 by incorporating the subject matter of claim 3. Thus, claim 1 as amended has been found by the Examiner to be directed to patentable subject matter. The amendment to claim 1, and the similar amendment to claim 21, renders all of the anticipation/obviousness rejections moot. Accordingly, reconsideration and removal of the anticipation/obviousness rejections is requested.

Appl. No. 09/890,357

4. Allowable Subject Matter

The Examiner has indicated that claims 3, 11-13, 18-19, 33, 35 and 39-40 would be allowed if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Applicant has followed the Examiner's recommendation by incorporating the subject matter of claim 3 into claim 1 and making a similar amendment to claim 21. Applicant submits that these amendments render all of the dependent claims allowable as well.

Favorable consideration and early allowance of all the claims is requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Leonard R. Svensson (Reg. No. 30,330) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants respectfully petition for a two (2) month extension of time for filing a response in connection with the present application and the required fee of \$420.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Certificate of Transmission
I hereby Certify that this correspondence is being
facsimile transmitted to the Patent and
Trademark Office:
On July 12, 2004
Sander B. Laurin
Signature
Sander B. Laurin
Typed or printed name of person signing certificate

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Kolman Kelly #46,183
for Leonard R. Svensson, #30,330

P.O. Box 747
Falls Church, VA 22040-0747
(714) 708-8555

LRS/KR
0696-0180P

Attachments